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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,244	04/23/2001	Y. Tom Tang	PF-0620 USN	3310

7590

04/22/2003

Incyte Genomics Inc
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EXAMINER

MAYES, LAURIE A

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 04/22/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830,244

Applicant(s)

TANG ET AL.

Examiner

Laurie Mayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, 2, 15, 17 and 19, drawn to a polypeptide and a method of using a polypeptide to treat a disorder, classified in class 530, subclass 300.

Group II, claim(s) 3-6 and 9-14, drawn to a polynucleotide, nucleic acid constructs and a method of using the polynucleotide to make a polypeptide, classified in class 435, subclass 69.1.

Group III, claim(s) 7 and 8, drawn to a method of detecting a polynucleotide, classified in class 435, subclass 6.

Group IV, claim(s) 16 and 18, drawn to an antibody and an antagonist (i.e., an antibody) of the polypeptide, classified in class 435, subclass 326.

Group V, claim(s) 20, drawn to a second process of use that uses an antagonist to treat or prevent a disorder, classified in class 435, subclass 326.

The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Groups I and II are unrelated as Group I is a polypeptide which may be used to treat a disorder and which has a different structure, function and effect than the polynucleotide of Group II that may be used to encode a polypeptide. Groups I and III are unrelated as the polypeptide of Group I is not used in the method of detecting a polynucleotide of Group III. Group I is unrelated to Group IV as the polypeptide of Group I may be used to treat a disorder and has a different structure, function and effect than the antibody of Group IV which responds to a specific antigen. Groups I and V are unrelated as the polypeptide of Group I is not used in the method of treating a disease of Group V. Groups II and III are unrelated and have different functions as Group II is drawn to a method of using a polynucleotide to encode a polypeptide while Group III is drawn not to a method of using a

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polynucleotide but to a method of screening a polynucleotide. Groups II and IV are unrelated as the polynucleotide of Group II may be used to encode a polypeptide and has a different structure, function and effect than the antibody of Group IV which responds to a specific antigen. Groups II and V are unrelated as the polynucleotide of Group II may be used to encode a polypeptide while the method of Group V does not use a polynucleotide. Groups III and IV are unrelated as the antibody of Group IV is not used in the method of detecting a polynucleotide of Group III. The method of detecting a polynucleotide is unrelated to the method of using an antibody to treat a disease as the polynucleotide and antibody in the methods are different structures with different functions and the methods have different purposes and uses. Groups IV and V lack unity of invention because the method of Group V is a second method of use of an antagonist of the polypeptide of claim 1 and PCT Rules do not allow for multiple processes. Further, a small fragment of the polypeptide of SEQ ID NO: 1 is known in the art (WO 98/43478; see copy of sequence alignment). Thus, these groups are not so linked as to correspond to a single general inventive concept as a whole over the prior art.

A telephone call was made to Diana Hamlet-Cox on April 18, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Mayes whose telephone number is (703) 605-1208. The examiner can normally be reached on Monday through Friday from 9AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (703) 305-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1123.

L. Mayes

Laurie Mayes
Patent Examiner
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April 21, 2003

Christopher S. F. Low
CHRISTOPHER S. F. LOW
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600